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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
C9/684,012	10/06/2000	Babak Rezvani	COR185-150117	9816

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NEW YORK, NY 10036-5803

EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/684,012

Applicant(s)

REZVANI ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19, 20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Status of Claims***

1. Claims 1-17, 19, 20, 22 and 23 have been examined.

***Responses to Amendments/Arguments***

2. The Examiner recommends that the Applicant when constructing claims 1, 14 and 23 should follow the Applicant's authentication steps of page 24, lines 5-14, page 25, lines 1-9, and page/line 27/19-(amended)29/8 (i.e. "Client usage patterns) of the Specification, as it clearly details the processes that claims 1, 14 and 23 attempt to model. Specifically, pages 27-29 spell out the instance when N is a variable.

Applicant's arguments with respect to claims 1-17, 19, 20, 22 and 23 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 14 and 23 recite the transmission of a "selected value of N". However, the claim also recites the limitation of setting "the number of tokens being set to a variable N". Therefore, to one of ordinary skill the term "selected value of N" means a client transmitting to a server a "subset" of the N number of tokens. The Specification, on the other hand, recites a client informing a server the value of N and transmitting N tokens for future authentication (Specification, amended page 28).

Claims 2-13 and 15-19, 20 and 22, are also rejected as they depend from claims 1 and 14 respectively.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 14 and 23 recite conflicting steps regarding what actions are to be performed by a client during a “first secure transmission”. It is not clear whether the Applicant in the step of transmitting “a selected value of N and N number of tokens to be used to authenticate the sender computer” is referring to a subsequent “first secure transmissions” or just the one “first secure transmission” detailed in the first three steps of the claim (claims 1, 14 and 23).

Claims 2-13 and 15-19, 20 and 22, are also rejected as they depend from claims 1 and 14 respectively.

b. Claims 1, 14 and 23 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Where the number N defines the number of additional transmissions.

Claims 2-13 and 15-19, 20 and 22, are also rejected as they depend from claims 1 and 14 respectively

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 6-11, 14, and 15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Pickett, U.S. Patent No. 6,012,144.

As per claims 1-3, 6-11, 14, and 15, Pickett teaches a transaction security method and apparatus comprising:

- transmitting a token to a receiver during first secure transmission between a sender and receiver (abstract; figure 4; column 3, lines 50-52)
- establishing at least one additional transmission between the sender and receiver for transmitting the token, wherein the additional transmission is variable and adaptively selected (figures 4 and 5; column 3, lines 50-54; column 6, lines 22-35)

- comparing the tokens received during the transmissions to establish authenticity (figures 4 and 5; column 6, lines 23-35 and 64-67)
- wherein the at least one token comprises and corresponds to a preselected number of tokens sent during a first secure transmission (figures 4 and 5)
- conducting transmissions over unsecure or open connections (figure 1)
- conducting an encrypted first secure transmission (figures 3A-4; column/lines 5/1-6/23)
- additional transmissions that are sent in plaintext (figures 1 and 5; column 6, lines 22-35)

Pickett also teaches a sender computer transmitting to a receiver computer a selected value of  $N$  and  $N$  number of tokens to be used to authenticate the sender computer (figures 4 and 5) as, for the case of  $N=1$ , the user “informs” the server of the value of  $N$  by registering at least one token to be used for future purchases.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 5, 12, 13, 16, 17, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, U.S. Patent No. 6,012,144.

As per claims 4, 5, and 22, Pickett teaches a secure transaction method that comprises multiple transmissions and the exchange of token data (figures 4 and 5). Pickett does not specify a particular number of additional transmissions. However, it would have been obvious for a user to register multiple cards but only make one purchase using the service of Pickett, or register one card and make multiple purchases using the one card. Similarly, as the number of additional transactions of the Pickett system is variable, the number can be ascertained mathematically (i.e. deterministically), or at least statistically, or probabilistically. And the choice independent variables used to model the behavior of said variable as at the discretion of the practitioner.

As per claims 12, 13, 16 and 17, Pickett teaches transmitting data electronically (figures 1-5). The Examiner takes Official Notice that checksums are well known computational tools for detecting the presence of errors when



data is transmitted over a network. Therefore, it would have been obvious to one of ordinary skill to use "checksums" to detect errors during the transmission of sensitive data such as credit card numbers.

As per claims 19 and 20, Pickett teaches a secure transaction method that comprises additional transmissions to a client (figure 5). Regarding the number of additional transmissions, it would have been obvious for a user to decline using the system of Pickett, or at least a particular website (i.e. ABC Toy Company), (figure 5) in the future if the user was dissatisfied with the service.

10. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickett, U.S. Patent No. 6,012,144 in view of Maher, U.S. Patent No. 6,125,349.

As per claim 23, Pickett teaches a method and system for authenticating transferred data between a sender computer and receiver computer comprising:

- transmitting a token to a receiver during first secure transmission between a sender and receiver (abstract; figure 4; column 3, lines 50-52)
- establishing at least one additional transmission between the sender and receiver for transmitting the token, wherein the additional transmission is variable and adaptively selected (figures 4 and 5; column 3, lines 50-54; column 6, lines 22-35)

- comparing the tokens received during the transmissions to establish authenticity (figures 4 and 5; column 6, lines 23-35 and 64-67)
- wherein the at least one token comprises and corresponds to a preselected number of tokens sent during a first secure transmission (figures 4 and 5)

Pickett also teaches a sender computer transmitting to a receiver computer a selected value of N and N number of tokens to be used to authenticate the sender computer (figures 4 and 5). However, Pickett does not explicitly recite specific criteria as input in an algorithm to determine the number of additional transmissions. Maher teaches a system for authenticating transferred data between a sender computer and receiver computer that uses an algorithm to determine additional transmissions based on frequency of transmissions between sender and receiver, proximity of the sender computer to the receiver computer or usage pattern of the sender (column 6, lines 25-48; column 7, lines 5-25). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Pickett and Maher in order to increase usage of the system through a rewards program (column 7, lines 5-25).

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

March 2, 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600